

REMARKS

Claims 1-4, 7, and 8 are now pending in this application for which applicant seeks reconsideration.

Amendment

Claims 5 and 6 have been canceled, and independent claim 2 has been amended to substantially incorporate the subject matter of claims 5 and 6. Moreover, claim 2 has been amended to clarify that the colored clear coating is applied directly over the surface of the injection-molded article. Claim 8 has been amended to remove the language “to simulate wood grain” to overcome the §112 rejection. No new matter has been introduced.

§ 112 Rejection

As claim 8 no longer contains any reference to “wood grain,” the § 112 rejection has been rendered moot. Applicant, however, notes that claim 8 as previously amended called for forming marbelized patterns “to simulate wood patterns.” Claim 8 therefore did not call for forming a wood grain pattern *per se*. Moreover, since the “wood grain” pattern is a “faux finish” as recognized by the examiner, it would cover any patterns that give the impression of a “wood pattern” to the viewer.

Art Rejection

Claims 2-8 were rejected under 35 U.S.C. § 103(a) as unpatentable over Langlois (USP 4,125,582) alone or Langlois in view of Beltarmo (EP 1 112 781). Applicant traverses these rejections because neither Langlois nor Langlois in combination with Beltarmo would have taught 1) directly applying a colored clear coating over the surface of an injection-molded product, and 2) the features of original claims 5 and 6 now incorporated in independent 2.

First, in rejecting the claims, the examiner again contends that it would have been obvious for one of ordinary skill in the art to apply a colored transparent layer over the molded product to change its color or appearance. This time, the examiner relies on Beltarmo to support the examiner’s contention. Beltarmo indeed discloses adding a tinted clear coating on a painted plastic surface to vary the tone and shading of the underlying paint. See paragraphs 18 and 22 in particular. Beltarmo, however, calls for providing a tinted clear coating over a **painted** surface, not directly over the naked plastic surface. Accordingly, applicant submits that the

combination would not have taught providing a clear coating directly over a naked injection molded product to alter its contrast and hue.

Second, in rejecting dependent claims 5 and 6, the examiner merely states that it would have been obvious to have varied the processing conditions and choices of plastic materials depending on what appearance was desired. To reject a claim under § 103, the seminal Supreme Court case, *Graham v. John Deere*, requires the examiner to first establish a *prima facie* case of obviousness. To do this, the PTO must identify a teaching or suggestion of the desirability of doing what the inventors here have done. That is, to establish that the claimed invention is directed to an obvious subject matter, either the applied reference(s) must expressly or implicitly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why an ordinary artisan would have found the claimed invention to have been obvious in light of the teaching(s) of the applied reference(s). See MPEP §§ 2142, 2143. The suggestion or the examiner's reasoning, however, must be objective and supported by evidence.

Here, the examiner merely states a conclusion without providing any support. Indeed, in rejecting claim 5, the examiner fails to explain why one of ordinary skill in the art would have set the temperature of the region near a material supply section of the cylinder of the injection molding machine lower than the temperature of the region near a nozzle of the cylinder. Similarly, in rejecting claim 6, the examiner fails to explain why one of ordinary skill in the art would have set the moving speed of the screw of the injection molding machine differently along the stages, let alone setting the speed lower in the upstream stage than in the downstream stage.

If the examiner maintains the same rejection, applicant requests the examiner to fully explain the reasons for the rejection and provide prior art support for the examiner's conclusion.

Conclusion

Applicant submits that claims 1-4, 7, and 8 patentably distinguish over the applied references and are in condition for allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicant urges the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

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DATE

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